REMARKS

The Office Action mailed March 31, 2004 has been carefully considered by the undersigned attorney on behalf of the inventors and their assignee. Amendments to this application have been presented in this paper in response to the Office Action.

In that Office Action, all pending claims were rejected again, much like the earlier Office Action which was received in this patent application. The rejections as unpatentable which have been presented have been based on a prior art patent to Liu, a prior art patent to Tominaga, a prior art patent to Salam. a prior art patent to Kamper, a publication by Silverman, a published patent application of Gvily, a published patent application of Horowitz, a published patent application of Sears, and a publication by Huynh. These several references were used, either alone or in combination, to provide rejections of the pending claims, primarily under 35 USC 103.

The first item of note in the prosecution of this patent application is that a large number of diverse references have been cited and applied to reject the pending claims. If the present invention was as "obvious" as the Office indicates, then a single reference or a small number of references should be available to show the invention, as opposed to bits and pieces from a myriad of diverse references, cited for bits and pieces of the invention.

Secondly, there is little reason to combine the references, short of using applicants' own teaching and claims, a sort of "hindsight reconstruction" of applicants' invention based on the teachings and claims presented. Of course, hindsight is impermissible. Further, each of the references must show a reason for combining or a motivation, and the burden is on the Office to demonstrate that reason. It is suggested that the motivation from the actual references is weak, at best, in the assembling of the art in the rejections of the present claims and is missing in some

instances, so at least some of the rejections based on obviousness would not be supported on appeal.

In response to this Office Action, various claims have been amended to better define the scope of the present invention and new claims have been added which are believed to distinguish from the art cited.

The present invention, as described in the specification and illustrated in the accompanying drawings, is a novel and unobvious method, system and program for creating a web page or the code for creating a web page with hotlinks from text using various tools to determine what hotlinks to include. These tools are claimed in various combinations and include a dictionary for determining common words which can be excluded from consideration (as well as a determination that a word or phrase is not included in the dictionary), a list of past links which have been used (a "past links" list) in creating web pages, a list of words for which no links could be determined (a "no links" list), and a user input to select a link from a plurality of links and to determine that no links are appropriate for a word or phrase. None of the references, alone or in combination, includes these features for a web page creation system or method, or, in the opinion of the undersigned, makes these claims obvious under 35 USC 103 and therefore not patentable.

The present invention has the advantage that it can take relatively large amounts of text (like product manuals or a magazine containing many articles with a large amount of text) and automatically narrow the amount of work required for a user to include appropriate hotlinks in a web page from the text. Thus the user can allow an automated tool to determine the possible hotlinks to web content based on using the dictionary (e.g., looking for words which do not appear in the dictionary) as well as filtering the text using terms which have been used

previously for hot links and words which have previously been determined not to require hotlinks.

The art does show some of the features of the present invention separate and apart from the present combination as claimed in the pending claims, but does not suggest their combination. In fact, some of the features shown in the cited art (like the dictionary in the Gvily publication) are not even shown for the purpose which it is used in the present invention. Further, the individual references do not recite or suggest a motivation to combine the references, and those "motivations" which are mentioned in the Office Action are either not really suggested by material in the application or are specifically taught away from the motivation suggested. Thus, in the Gvily publication, the idea is to use a proxy to process the data from a text page and process it, impliedly without involving the user. In fact, the Gvily reference recites that the data is stored hidden from the user's view but retrievable by the system, describing an automatic system that is free from user input. Thus, the combination of the Gvily publication with the Liu patent to provide a user input is contrary to the processing by the proxy in the Gvily reference. Further, the use in Gvily of a dictionary is not for the purpose of determining common words for which no web site is to be found, but for processing the DOM of an HTML Page (see col. 2, para [0028] of the Gvily reference) As a matter of fact, the modification of Sears and Liu is recited as "for the purpose of locating recognized words" whereas the applicants' invention uses the dictionary to determine words which are not recognized, either directly or in some variation. The motivation for combining references in some cases appears to be based on applicants' own teaching, which is a form of impermissible hindsight reconstruction (see the motivation for combining the Tominaga patent with Sears, Liu and Gvily "to include a dictionary augmented by rules for the purpose of efficient translation",

which does not provide a reason for the dictionary or for the rules, except that it somehow would be efficient to do so.

Claim 14 as amended calls for a system for creating code for a web site in which the system includes a comparison to a dictionary for determining words in the text which are not found in the dictionary, as well as for determining that a web site is associated with the word or phrase. It further requires a user input as to whether a site should be included and, if there is more than one web site, receiving a user input as to which of the web sites to be associated with the word or phrase.

Claim 22 includes a program component which identifies a portion of the text for which a dictionary entry does not exist and seeks to locate a web site for the portion of the text where it determines that there is no dictionary entry. It also calls for receiving a user input whether to include a web site link and selecting the web site if more than one web site was identified. Thus, Claim 22 identifies web sites for portions of text which are not present in the dictionary. This allows the filtering out of common words which are included in a dictionary without using the search engine to identify these common words for which no web site may be relevant, a clear advantage over systems which do not use such filtering.

Claim 39 describes a method of creating a web page which includes using a dictionary to determine words and phrases for which a dictionary entry does not exist and using the words and phrases for which no dictionary entry exists in the step of comparing words and phrases for which a web site is found.

Claim 52, which calls for determining which links to consider based on comparing text with a dictionary, a "no links" list and a "prior links" list, as well as using a user input, to determine which words and phrases should have a hotlink. None of the art cited includes

reference to a dictionary, a "no links" list and a "prior links" list, as well as a user input to determine whether the include a hotlink to the word or phrase in text under consideration.

The pending independent claims thus include limitations not seen or suggested in the references, alone or in permissible combination, and are therefore believed patentable.

All of the presently pending claims depend, either directly or indirectly, from the independent claims, discussed above and are believed patentable because the independent claims are urged to be patentable

The pending claims, Claims 14 - 28 and 39 - 56, are therefore believed to be allowable over the art of record because the art simply does not teach the claimed inventions..

Applicants and their attorney want to get this patent application in condition for allowance at an early date, especially since the primary grounds of claim rejections are based on two prior art references, alone or in combination, which are substantially different from the present invention. To assist the Examiner in getting this application in condition for allowance if any questions remain, a collect call to the undersigned is authorized at the Examiner's convenience if any questions or issues remain after consideration of the rationale which has been presented in this Amendment.

The present Office Action was made final, so this an amendment after final. It is urged that the present amendments, taken together with these Remarks, demonstrates that the present amendment puts to claims in condition for allowance and should be entered for that reason.

Accompanying this Amendment is a Conditional Request for Continuing Examination (RCE). Applicants hereby request such continuing examination in the event that all claims are not in condition for allowance. That paper includes a charge for the requisite RCE fees to the Deposit Account of the assignee of this patent application.

A Petition for Extension of Time and an authorization to charge my Visa account for the extension fee accompanies this paper. It is believed that no other fee is required for the filing of this paper, since the number of claims currently pending does not exceed the number of claims for which the fees have already been paid (38 total claims and 6 independent claims). However, if any additional fee is due in connection with the filing of this paper, including any patent application processing fees, the Patent Office is authorized to charge those fees to Deposit Account 50-0510 maintained in the name of International Business Machines Corporation (IBM), the assignee of the present application.

Respectfully submitted,
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EXHIBIT

(although this is not believed required by the current amendment practice, here is a copy of the amended claims with markings showing insertions and deletions for the purpose of assisting the Examiner)

14. (currently amended) A system which creates at least part of the code for a web site comprising:

a parser which separates text into words and phrases;

a system which compares the words with a dictionary to identify words which do not appear in the dictionary and which compares the words and phrases with entries not appearing in the dictionary for which a web site is available and generates an output for display to a user indicating one or more web site associated with one of the words and phrases;

a system which receives a user input indicating whether a web site should be associated with a word or phrase and which one or more of the web sites should be associated with the word and phrase; and

an editing system which generates a web site for the text which includes a hotlink for the web site(s) indicated by the user input if the user has indicated that a web site should be associated with the word and phrase.

22. (currently amended) A stored program for creating at least part of the code for a web site based on a text, the stored program comprising:

a program component which identifies a portion of the text for which a web site may exist for a portion of the text;

a program component which compares the portion of the text to a dictionary to determine that a dictionary entry for the portion does not exist;

a program component which seeks to locate one or more web sites for the identified portions of text where the dictionary entry of the portion does not exist;

a program component which displays to a user for user input the one or more located web sites which are associated with an identified portion of the text;

a program component which responds to a user input to select whether to include a web site and, if more than one web site is identified, to select which web site or web sites will be included; and

a program component which creates a web site based on the text and includes a hot link to the one or more web sites which were selected by the user.

39. (currently amended) A method of creating a web page comprising the steps of

parsing text to separate it into words and phrases;

using a dictionary to determine words and phrases for which no dictionary entry is found;

comparing at least some of the words and phrases with entries for which a web site is available using the words and phrases for which no dictionary entry is found and generating an output to a user indicating one or more web sites associates with at least one of the words and phrases;

receiving a user input which indicates whether a web site should be associated with a selected word or phrase and, if more than one web site has been identified, identifying which of the more than one web site should be associated with the selected word or phrase; and

editing the text to include a hotlink for the selected word or phrase based on the user input, if the user input indicates that a web site should be associated with the selected word or phrase.

52. (currently amended) A method of creating a web page comprising the steps of:

parsing text to separate it into components including words and phrases;

comparing components from the parsing with a dictionary, a "no links" list and a "past links" list to determine which components are likely to have at least one web site associated with the component;

receiving a user input which indicates whether a web site should be associated with the text [web] component and, if more than one web site has been identified, identifying which of the more than one web site should be identified with the selected word or phrase;

editing the [text] web page to include a hotlink for the selected word or phrase based on the user input, if the user has indicated that a web site should be associated with the text component.